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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
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Hearing:
June 28, 2001

Paper No. 24
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Red Hawk Tobacco Company

Serial No. 75/284,502

Stephen T. McMurtry for Red Hawk Tobacco Company.

Jennifer Stiver Chicoski, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Quinn, Chapman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Red Hawk Tobacco Company has filed an intent-to-use application to register the mark set forth below

for "chemical-additive free cigarettes," in International Class 34.¹ The Examining Attorney has refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d). The ground is that applicant's mark, if used in connection with the identified goods, would be likely to cause confusion or mistake or to deceive consumers, in view of the prior registration² of the mark set forth below for "smoking tobacco":



¹ The original identification of goods included "cigarette tobacco" but applicant, in its reply brief on appeal, asked that such be deleted and the identification restricted to "chemical-additive free cigarettes." During the oral hearing, applicant confirmed that its request was unequivocal and not presented as part of an alternative argument against the refusal of registration. Since the amendment limits the identification, the request to amend is granted.

² Registration No. 1,263,754 issued January 10, 1984, and lists September 16, 1982 as registrant's date of first use and first use in commerce. The registration includes a disclaimer of the word "Blend."

When the refusal was made final, applicant appealed. Both applicant and the Examining Attorney have filed briefs and presented oral arguments to the Board. We reverse the refusal.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. duPont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion presented by this case, key considerations are the similarities or dissimilarities of the marks, the similarity or dissimilarity of the goods, and the market interface of applicant and the owner of the cited registration. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first consider the involved goods. We note that registrant's identification of services contains no limitation as to the purposes or uses for its "smoking tobacco." Applicant has argued at length that such term is "synonymous in the trade with pipe tobacco." The Examining Attorney, however, argues that there is nothing in the record to support this contention. We agree.

Applicant has entered material in the record in an attempt to establish that registrant markets only pipe

tobacco and small cigars made of pipe tobacco, but this does not establish that "smoking tobacco," as used by others, would only mean pipe tobacco or products made therefrom. Likewise, applicant has cited repeatedly to various federal and state statutes and regulations governing the taxation, labeling and marketing of tobacco products, particularly cigarettes. Applicant has not, however, submitted anything to establish that under these various laws or regulations "smoking tobacco" means only pipe tobacco. In short, we agree with the Examining Attorney that, for purposes of our analysis of likelihood of confusion, we must consider "smoking tobacco" to be inclusive of cigarette tobacco.

In any event, even if goods identified in an application and registration are not similar or competitive, there may still be a likelihood of confusion, when similar marks are used in conjunction therewith, if such goods are related in some manner and/or if the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under conditions that would give rise to the mistaken belief that the goods emanate from or are in some way associated with the same source or sponsor. See *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-1027 (TTAB 1984), and

cases cited therein. In this regard, the Examining Attorney has stated that the pertinent question is not whether a cigarette or pipe smoker would mistakenly purchase goods intended for the other but, rather, whether a pipe smoker familiar with registrant's goods and in search of cigarettes would believe, when encountering applicant's goods, that the source of those cigarettes had some connection with registrant. Finally, we note that applicant's counsel, at the oral hearing, acknowledged that applicant's and registrant's goods, though different in type, are related, and that the essential basis for applicant's contention that there is no likelihood of confusion relates to differences in the marks and the parties' consent agreement. Thus, while we find the goods related, we turn our attention to the marks and the parties' market interface to complete the analysis of likelihood of confusion.

The mark applicant now seeks to register is different from that which was displayed on the original drawing sheet. The original mark included a virtually identical depiction of a horse, but running in the opposite direction, i.e., in the same direction as the horse in the mark of the cited registration. In addition, the horse was depicted at the top of the composite mark, just above the

words "KENTUCKY BLONDES." In refusing registration of this original mark, the Examining Attorney noted that both applicant's mark and registrant's mark feature similar galloping horses running in the same direction; that the marks display their respective images directly over the words in the marks; that, in each mark, Kentucky is the first of these words; that the words KENTUCKY CLUB CONTINENTAL BLEND and KENTUCKY BLONDES appear in a similar font; and that each mark includes similar sounding terms which are descriptive of the goods, i.e., "BLEND" and "BLONDES."

The record reveals that when applicant sought registrant's consent to applicant's registration of its mark, the registrant expressed concerns about possible confusion among consumers remarkably similar to the Examining Attorney's concerns. Specifically, registrant's general counsel noted, in a letter to applicant's counsel, that the respective goods "belong to the same class" and that each mark contains "a galloping horse. ...left facing and positioned directly above the word 'KENTUCKY' which word is printed in virtually the same type font." Registrant's counsel went on to request that applicant "make sufficient changes to its mark and overall package

design, including its color scheme, so that it is distinguishable from our company's."

As a result, applicant changed its mark to that set forth at the outset of this decision. The Examining Attorney determined that the changes in the mark did not result in substitution of a materially different mark and approved the amendment.³ Nonetheless, the Examining Attorney maintained the refusal of registration, arguing that KENTUCKY is the dominant term in each mark, notwithstanding that applicant has disclaimed it, and that the respective horse designs yield similar impressions. Thus, the Examining Attorney concludes that "applicant has appropriated two significant portions of the registrant's mark, the geographic term 'KENTUCKY' and the image of the horse, and merely added highly descriptive wording to the beginning and end, such that the commercial impressions of the marks are so similar that purchasers are likely to believe that similar goods with these marks emanate from a common source."

³ Though the mark was changed, applicant and the Examining Attorney did not agree to delete the "lining and stippling" statement previously entered in regard to the original version of the mark. It is, however, inappropriate to print such a statement on any registration that may issue, in view of the amendment of the mark. Accordingly, the statement shall be deleted from the application.

Applicant "does not concede that its mark ever created the same overall impression" as registrant's and argues, "the divide is now even wider" since applicant changed its mark. Applicant argues that its design "features a rightward-facing, young, blond, free-spirited, wild thoroughbred about to leap off the cigarette package itself into the presence of the smoker. This thoroughbred is alive and vigorous. Registrant's mark has a totally different appeal. Their horse is not real, but rather a ...leftward-facing statue attached to a weathervane, much like a carousel horse is attached to a carousel. ...poles attach this statue to a ...shield, which contains the words 'Kentucky Club Continental Blend'." Applicant concludes that its mark appeals to "a cigarette smoker's desire for freedom" while registrant's mark appeals to "a pipe or cigar smoker's desire to be an aristocratic 'club' member."

Applicant also argues that it did not, contrary to the Examining Attorney's characterization, appropriate the dominant elements of registrant's mark. Instead, applicant contends, any combination of an image of a horse and the word Kentucky is quite natural, in view of the state's strong identification with racing horses. In addition, applicant argues that Kentucky is home to half the nation's tobacco farms and there is, therefore, nothing arbitrary

about using the name Kentucky for tobacco products. Thus, applicant concludes neither applicant's own mark nor registrant's mark is particularly strong or entitled to a broad scope of protection.⁴

Applicant also argues that its goods are "upscale, all natural cigarettes," expensive and will be purchased by consumers exercising care and attention.

Finally, applicant argues that it negotiated changes in its mark and package design with registrant and "has gone to great lengths to address the concerns of the registrant and registrant is no longer opposed to applicant's mark." Of record is a second letter to

⁴ Applicant's references to the renown of Kentucky's thoroughbred and tobacco industries are set forth in its reply brief and are supported by citations to Internet web sites, some of which are on-line dictionaries. Applicant did not, however, submit printouts from any of these sites. These contributions to the record were improperly offered and untimely, and have not been considered. See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998), in regard to the form of the proffer; see *In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999) and Trademark Rule 2.142(d), in regard to the untimeliness of the proffer.

Notwithstanding our refusal to consider this material, we take judicial notice of the following "hard-copy" dictionary listings:

Kentucky ...2. an east central state of U.S.A.,... *Chief Products:* Tobacco, corn, wheat; thoroughbred horses, cattle, hogs...
Merriam-Webster's Geographical Dictionary 583 (3rd ed. 1997).

Kentucky, state ...SE central U.S. ...The state is noted for the distilling of Bourbon whiskey...and for the breeding of thoroughbred racehorses. In 1990 the state, esp. in W, N, and central Ky., was also the 2d-largest U.S. grower of tobacco... Tobacco has long been the state's chief crop, and it is also the chief farm prod., followed by cattle, horses, and dairy prods.
The Columbia Gazetteer of North America 506-07 (2000).

applicant's counsel from registrant's general counsel,
which states, in part:

We have reviewed the new package design for Red Hawk Tobacco's Kentucky Blondes cigarettes. We appreciate the changes which your client made to their package design.

While we are not sure if the changes made will be sufficient, we are willing to abide by the determination of the Trademark Office on the new design. Should this new design be acceptable to the Trademark Office, we do not intend to oppose Red Hawk's registration of the new design.

Applicant contends that the Examining Attorney should have accepted this letter as manifestation of registrant's consent to applicant's registration of its amended mark.

We agree with applicant that the overall commercial impressions of the respective marks are different. Visually, they are similar only insofar as each employs a horse design and the word KENTUCKY. The horses, however, look different, and we agree with applicant that applicant's appears as an illustration of a "live" horse while registrant's appears as a representation of a horse as it might be presented on a carousel or weathervane, or perhaps even a crest or shield.⁵ Given the association of thoroughbred horses with the state of Kentucky, adoption of

⁵ Though we find the respective horse images different, we have not based this conclusion in any way on applicant's argument that the respective horses have different coloring. The Examining Attorney is entirely correct that neither mark is restricted to particular colors.

the image of a horse for use in connection with the word KENTUCKY is not particularly arbitrary. Under such circumstances, one party's adoption of a horse design should not yield it a monopoly and preclude others, even when products are related, from adopting dissimilar horse designs. Other visual differences between the marks are the particular fonts used for the words and the different carriers or geometric elements framing these words.

In regard to the sounds of the marks, because of the dominance of words over designs when the question is how marks will be articulated, we are faced with a comparison of KENTUCKY BLONDES and KENTUCKY CLUB CONTINENTAL BLEND.⁶ Apart from the fact that each of these phrases begins with the word KENTUCKY, they are utterly dissimilar. We are not persuaded otherwise by the Examining Attorney's argument that BLONDES and BLEND are phonetically similar. If consumers would tend to abbreviate registrant's mark when calling for its goods, we believe they would tend to call for KENTUCKY CLUB smoking tobacco, not KENTUCKY BLEND smoking tobacco.

⁶ Though the phrase ALL NATURAL CIGARETTES appears in the composite mark applicant seeks to register, this wording is generic for applicant's goods, could just as readily have been deleted from the drawing as disclaimed, and would not be perceived as part of the mark because they are devoid of source-indicating significance.

As to the connotations of the marks, applicant contends that its composite mark creates a "triple entendre referring to blond horses, blond women, and blond tobacco⁷," and that this is distinctly different than the connotation of an aristocratic club engendered by registrant's mark. The Examining Attorney, in contrast, contends that consumers would not view KENTUCKY BLONDES as creating even a double entendre. We need not determine precisely how many ideas the words in applicant's mark would conjure up for a consumer before we can conclude that any possible connotation would be different than that of registrant's mark, which, we agree, would be viewed as evocative of a club of some kind.

In short, we find the composite marks dissimilar as to the traditional three factors of sight, sound and meaning and on this basis alone find no likelihood of confusion. Moreover, if the *duPont* factors did not favor applicant and were equally weighted on the issue of likelihood of confusion, we would, in this case, find the consent to registration provided by registrant sufficient to tip the

⁷ Applicant notes, in particular, "Kentucky is commonly associated with horses, like the blond horse featured on [applicant's] package. Blond is also a word used to identify fair-haired individuals, including Kentucky's former governor, Martha Layne Collins and other Kentucky fair-haired women. [And applicant's cigarettes] contain Virginia blonde tobacco."

balance in favor of a finding of no likelihood of confusion and publication of applicant's mark for opposition.

The Examining Attorney argues that a bilateral agreement spelling out particular steps that applicant and registrant would take to avoid confusion of consumers would be a better form of consent. We do not disagree, however, the Examining Attorney conceded at the oral hearing that the second letter from registrant's general counsel could be considered consent to registration and that registrant probably would not oppose applicant's application. As the Examining Attorney acknowledged in briefing this appeal, our reviewing court has clearly stated, in numerous cases, that the considered opinions of parties as to the likelihood of confusion in the marketplace is a significant factor to be considered in the *duPont* analysis, and we see no reason to protect registrant from the consequences of what the Examining Attorney views as an unwise consent to registration of applicant's mark.

Decision: The refusal of registration is reversed.